

REMARKS

This Amendment is being filed in response to the April 2, 2007 Office action issued in connection with the above-identified patent application. Applicant believes that the preceding amendments address the Examiner's concerns regarding the pending claims and place the application in condition for allowance. Reconsideration of the Office action is requested in view of the foregoing amendments and the following remarks.

Prior to entry of the above amendments, claims 1-39 were pending. In response to a restriction requirement, Applicant elected, without traverse, to prosecute claims 2, 8, 14-22, 24, and 34. Upon entry of this response, claims 1-13, and 23-39 are canceled without prejudice, claim 18 is amended, and claims 40-49 are added. Thus, prosecution is proceeding on claims 14-22 and 40-49. Applicant believes that the amendment to claim 18 and the subject matter recited in the new claims are supported by the application as filed and are within the scope of the Examiner's original search.

Claims 2, 8, 24, and 34 stand objected to as being dependent on non-elected claims. Claims 2, 8, 24, and 34 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,270,549 to Amick ("the Amick patent"). Claims 14-22 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 8, 13, and 16 of co-pending U.S. Patent Application No. 10/041,873 ("the Amick Application").

Applicant has studied the cited references in view of the reasons expressed in the Office action, and Applicant respectfully traverses the rejections. Nonetheless, claims 2, 8, 24, and 34 have been canceled without prejudice, claim 18 has been amended, and claims 40-49 have been added. Applicant requests reconsideration of the rejections in

view of the presently amended and newly presented claims and the reasons expressed below.

Election/Restriction

Applicant affirms the election, on March 21, 2007, of claims 2, 8, 14-22, 24, and 34 (“Invention II”) for further prosecution. Applicant further confirms that, by election, claims 1, 3-7, 9-13, 23, 25-33, and 35-39 were withdrawn from consideration as being drawn to a non-elected invention. In the above amendments, claims 1, 3-7, 9-13, 23, 24-33, and 35-39 are cancelled without prejudice. Applicant is not abandoning the subject matter of these non-elected claims, nor claims that depend therefrom, and Applicant understands that prosecution of these claims may be resumed in a related application.

Claim objections, and claim rejections under 35 U.S.C. § 103

Claims 2, 8, 24, and 34 stand objected to as being dependent on non-elected claims. Claims 2, 8, 24, and 34 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,270,549 to Amick (“the Amick patent”).

Applicant cancels without prejudice claims 2, 8, 24, and 34 in this response. Accordingly, the objections to and rejections of those claims are rendered moot.

Non-statutory obviousness-type double patenting

Claims 14-22 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 8, 13, and 16 of co-pending U.S. Patent Application No. 10/041,873 (“the Amick Application”). The Examiner noted that such a rejection “is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the

reference claims because the examined application claim is either anticipated by, or would have been obvious over, the reference claims.” Applicant appreciates the Examiner’s thoroughness in considering the recited subject matter. However, Applicant respectfully disagrees that the examined claims are not patentably distinct from any claim, including claims 1-3, 5, 8, 13, and 16, of the Amick Application. However, Applicant notes that the Amick Application issued as U.S. Patent No. 7,217,389 on May 15, 2007. Accordingly, Applicant submits that the provisional obviousness-type double patenting rejection is rendered moot by the issuance of the Amick Application as a patent.

For the purpose of completeness, Applicant also submits that the pending claims are patentably distinct from the issued claims of the ‘389 Amick patent and that a double patenting rejection would not be appropriate. Claim 1 is the sole independent claim of the ‘389 Amick patent. Claim 1 of the ‘389 Amick patent is reproduced below for the Examiner’s convenience:

1. A firearms cartridge, comprising:
a casing;
a primer;
a propellant; and
at least one projectile having a density of at least 10 g/cc, wherein the projectile is formed by compressing a powder-form composition of matter that includes a tungsten-containing powder and a binder that includes a metallic binder component and a non-metallic binder component, wherein the metallic binder component includes at least 50 wt% tin, and further wherein the non-metallic binder component includes at least one of a thermoset resin or epoxy and comprises 0.25 to 3 wt% of the powder-form composition of matter.

As is evident by the above claim language, the claims of the ‘389 Amick patent recite subject matter that is clearly distinct from the claims of the pending application,

and vice versa. Amongst other subject matter, claim 1 of the '389 Amick patent recites a projectile formed by compressing a powder-form composition of matter that includes a binder with not only "a metallic ... and a non-metallic binder component," but also in which "the metallic binder component includes at least 50 wt% tin ... and the non-metallic binder component includes at least one of a thermoset resin or epoxy." The pending claims do not positively recite any binder, much less the binder recited in claim 1 of the '389 Amick patent.

Pending independent claim 14 recites, amongst other subject matter, firearms ammunition with at least one projectile that is "at least substantially comprised of a non-magnetic fraction of ferrotungsten-containing powder." Furthermore, independent claim 14 does not recite any binder, much less the binder of claim 1 of the '389 Amick patent. Accordingly, the projectile of claim 1 may or may not include a binder, and even if it does include a binder, the binder may be distinct from that of claim 1 of the '389 Amick patent. Furthermore, claim 1 of the '389 Amick patent recites only that the projectile includes a tungsten-containing powder. Perhaps more importantly, claim 1 and the entire disclosure of the '389 Amick patent fail to disclose or suggest forming at least a substantial portion of the projectile from a non-magnetic fraction of ferrotungsten-containing powder.

Accordingly, Applicant respectfully submits that claim 14 is patentably distinct from the '389 Amick patent and that a double patenting rejection would not be appropriate. As noted above, Applicant has added claims 40-49 to the present application. Of those, claims 44-45, and 48-49 are independent claims. Similar to claim 14, which was discussed above, each of these independent claims recites subject

matter that is not recited in claim 1, nor disclosed in the specification, of the '389 Amick patent.

In view of the above remarks and amendments, Applicant submits that all of the issues raised in the Office action have been addressed. If the Examiner has any questions, or if there are any remaining issues, Applicant expressly requests that Applicant's undersigned attorney be contacted at the number listed below. Similarly, if the Examiner believes that a telephone interview may be productive in advancing prosecution of the present application, the Examiner is invited to contact Applicant's undersigned attorney at the number listed below.

Respectfully submitted,

KOLISCH HARTWELL, P.C.



David S. D'Ascenzo

Registration No. 39,952

PTO Customer No. 23581

Kolisch Hartwell, P.C.

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679